

**This Opinion is Not a
Precedent of the TTAB**

Mailed: February 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Flex Ltd.

v.

Spireon, Inc.
—————

Opposition No. 91252138
—————

Pamela N. Hirschman and Autumn R. Hartman of Sheridan Ross P.C.
for Flex Ltd.

Michael J. Bradford of Luedeka Neely Group, P.C.
for Spireon, Inc.
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Notice of Correction

By the Board:

On January 25, 2022, the Board mailed a final decision in this proceeding.

It has come to the Board's attention that the Board's final decision, as originally issued, had some corrupted formatting, was missing evidentiary record page reference information in footnote 23 and contained a typographical error in the "Decision" sentence at the end.

In view thereof, the decision is corrected to fix the formatting errors, insert the missing information in footnote 23, and revise the typographical error in the “Decision” section. Attached hereto is a corrected form of the January 25, 2022 decision.

The time for filing an appeal or commencing a civil action by either party regarding the Board’s decision continues to run from the mailing date of January 25, 2022 decision. *See* Trademark Rule 2.145(d)(1), 37 C.F.R. § 2.145(d)(1).

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Before Cataldo, Adlin and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

This opposition involves products and services for monitoring the transportation of goods, and the means for transporting those goods, across the United States – an integral part of our “supply chain.” Specifically, Spireon, Inc. (“Applicant”) seeks registration on the Principal Register of the standard character mark FL FLEX for: “electronic devices for tracking the locations of mobile assets in the nature of trailers,

cargo containers, and other freight and transportation equipment using global positioning systems and cellular communication networks” in International Class 9.¹

In its Notice of Opposition,² Flex Ltd. (“Opposer”) opposes registration of Applicant’s FL FLEX mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant’s mark, as applied to the goods identified in the Application, so resembles Opposer’s registered marks:

Mark	Reg. No. Reg. Date Priority Date	Goods/Services
FLEX	4995935 July 12, 2016 March 20, 2015	Supply chain management services; transportation logistics services, namely, arranging the transportation of goods for others; logistics management in the field of electronics; procurement, namely, purchasing electronics for others and inventory management services for others; wholesale distributorship services in the field of electronics. Class 35 Packaging articles to the order and specification of others. Class 39 Manufacturing services for others in the field of electronics to order and/or specification of others; custom manufacture of electronics for others; technical support services, namely, providing technical advice related to the manufacture of electronics. Class 40 Engineering services, consulting services in the fields of new product development and electronics; new product design services; research and development of new products. Class 42
flex (As described in the registration,	4930741 April 5, 2016 March 20, 2015	Supply chain management services; transportation logistics services, namely, arranging the transportation of goods for others; logistics management in the field of electronics; procurement, namely, purchasing electronics for others and inventory management services for others; packaging articles to the order and specification of others;

¹ Application Serial No. 88169365 was filed on October 25, 2018, based on Applicant’s allegation of a first use of the mark anywhere and first use in commerce at least as early as February 15, 2018, under Trademark Act Section 1(a), 15 U.S.C. §1051(a).

² 1 TTABVUE. References to the pleadings, the evidence of record and the parties’ briefs refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page and paragraph references, if applicable.

Mark	Reg. No. Reg. Date Priority Date	Goods/Services
“[t]he mark consists of the word ‘FLEX’ in lower case letters with one line in the ‘X’ broken before and after the second line in the ‘X.’”		wholesale distributorship services in the field of electronics. Class 35 Manufacturing services for others in the field of electronics to order and/or specification of others; custom manufacture of electronics for others; technical support services, namely, providing technical advice related to the manufacture of electronics. Class 40 Engineering services, consulting services in the fields of new product development and electronics; new product design services; research and development of new products. Class 42
FLEX PULSE	5352889 December 12, 2017 July 9, 2015	Computers; computer software for use in supply chain management, logistics and operations management, quality control, inventory management, and scheduling of transportation and delivery; computer software in the nature of downloadable mobile applications for use in supply chain management, logistics and operation management, quality control, inventory management, and scheduling of transportation and delivery. Class 9 Supply chain management services; logistics management in the field of electronics; procurement, namely, purchasing of electronics, computer hardware and computer software, purchasing and sourcing of computers, computer systems and components and inventory management services for others; wholesale distributorship and ordering services and wholesale services via direct solicitation by sales agents, in the field of electronics; inventory control and inventory management services. Class 35 Engineering services; product development services; product design, engineering, research, development and testing services in the field of electronics; design and testing for new product development; information, consultancy and advisory services relating to all the aforementioned services; providing temporary use of non-downloadable computer software for supply chain management, logistics and operation, inventory control, inventory management and tracking of documents and products over computer networks, intranets and the internet in the field of supply chain management. Class 42

as to be likely to cause confusion, mistake, or deception. Opposer also alleges common law rights in its FLEX and **flex** marks in connection with “asset tracking devices.”

In its Answer, Applicant denied the salient allegations of the Notice of Opposition, and asserted three purported affirmative defenses.³ Applicant’s first “affirmative defense” of failure to state a claim upon which relief can be granted is not an affirmative defense. *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *4, n.5 (TTAB 2021) (citing *U.S. Olympic Comm. v. Tempting Brands Neth. B.V.*, 2021 USPQ2d 164, at *4 (TTAB 2021)). In any event, as Respondent neither filed a formal motion to dismiss pursuant to Fed R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in its brief, it is hereby deemed waived. *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013).

Applicant’s second affirmative defense that:

The Notice [of Opposition] fails by reason of the fact that use of the FL FLEX mark of U.S. Application Serial No. 88/169,365 (the “365 Application”) for the goods stated therein has not caused and is not likely to cause confusion, mistake, or deception with regard to the source of the goods vis-a-vis the source of Opposer’s goods and services allegedly provided under its FLEX and FLEX PULSE marks and that registration of Applicant’s FL FLEX mark of its ‘365 application for the goods listed therein has not caused and is not likely to cause any damage to any cognizable right or interest of Opposer.

is merely an amplification of Applicant’s denial of a likelihood of confusion. Although it is permissible to amplify such a denial, *Morgan Creek Prods., Inc. v. Foria Int’l*,

³ Answer, 5 TTABVUE.

Inc., 91 USPQ2d 1134, 1135-36 (TTAB 2009), this type of amplification is not, and should not be pled as, a separate “defense,” and we do not treat it as such here. *Sabhnani v. Mirage Brands*, 2021 USPQ2d 1241, at *4 n. 5 (TTAB 2021).

In its third affirmative defense, “Applicant reserves the right to assert such other and further defenses including, but not limited to, affirmative defenses, as it may become aware of in the course of this proceeding.” Applicant’s “attempt to reserve the right to add defenses is improper under the Federal Rules of Civil Procedure, because that would not give ... [Opposer] fair notice of such defenses.” *Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, *4 n.6 (TTAB 2021); *see also FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013) (“[A]ffirmative defenses that purport to reserve the right to add affirmative defenses at a later date ... are stricken because they are improper reservations under the Federal Rules.”).

The case is fully briefed. To prevail on its Trademark Act Section 2(d) claim, Opposer must prove, by a preponderance of the evidence its entitlement to a statutory cause of action, priority and likelihood of confusion. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000). Having considered the evidentiary record, the parties’ arguments and applicable authorities, as explained below, we find that Opposer has carried this burden, and sustain the Opposition.

I. The Evidentiary Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Applicant's involved application. In addition, the parties introduced the following evidence and stipulation:

A. Opposer's Evidence

- Opposer's Notice of Reliance ("O NOR"), with exhibits consisting generally of Opposer's pleaded registrations and TSDR database records pertaining thereto,⁴ Applicant's admissions' responses and interrogatory answers, third-party trademark registrations, Opposer's pending patent applications, two years of Opposer's annual reports ("Form 10-K") filed with the Securities and Exchange Commission; Internet news articles and electronic publications about Opposer and Applicant, and the promotional Internet web pages published by third parties as well as Opposer [16 TTABVUE].
- Opposer's Testimony Declaration of Bjorn Kilburn ("Kilburn Decl."), Opposer's former Vice President of Product & Engineering and General Manager of Tracking & Telematics Solutions Business Unit, with exhibits [17 TTABVUE, confidential; 18 TTABVUE, public and redacted].

B. Applicant's Evidence

- Applicant's Testimony Declaration of Karine Malzahn ("Malzahn Decl."), Applicant's Senior Director of Marketing, with exhibits [19 TTABVUE].
- Applicant's Notice of Reliance ("A NOR"), with exhibits consisting generally of TESS database records for Applicant's registrations of marks containing the term "FL ..." or the term "FLEETLOCATE," third-party trademark registrations of marks containing the term "... FLEX ...," an online dictionary definition of the term "FLEX," third-party websites promoting goods or services under names containing the term "... FLEX ...," and Applicant's interrogatory answers [20-22 TTABVUE].⁵

⁴ These materials were already made of record by way of attachments to Opposer's Notice of Opposition, and should not have been submitted again by way of Notice of Reliance. *ITC Entertainment Grp. Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (filing duplicative submissions is a waste of time and resources, and is a burden on the Board).

⁵ Applicant attempted to file its Notice of Reliance three times. 20 TTABVUE was corrupted except for the exhibits. 21 TTABVUE, filed without the exhibits, again was corrupted. 22 TTABVUE, again filed without the exhibits, is a readable document. In referring to Applicant's Notice of Reliance in this opinion, we shall cite to the exhibits submitted as part

C. Opposer's Rebuttal Evidence

- Opposer's Rebuttal Notice of Reliance ("O Rebuttal NOR"), with exhibits consisting generally of third-party trademark registrations [31 TTABVUE].⁶
- The transcript and exhibits from Opposer's oral cross-examination of Applicant's witness, Karine Malzahn, with exhibits [32 TTABVUE, confidential; 33 TTABVUE, public and redacted].

D. Parties' Stipulation

- The parties' stipulation clarifies the meaning of "Spireon's letter" discussed in paragraph 18 of Ms. Malzahn's testimony declaration [29 TTABVUE].

II. Readability of Applicant's Trial Brief

Portions of Applicant's Trial Brief are corrupted, and therefore unreadable. In reviewing the brief, we endeavored to determine the nature and intent of Applicant's arguments where possible. However, we could not discern some of the points Applicant attempted to make from mangled or non-appearing text. The readability of Applicant's Trial Brief filed with the Board was Applicant's responsibility. Trademark Rule 2.126(a)(2), 37 C.F.R. § 2.126(a)(2) ("Submissions ... made to the ... Board ... must be made electronically ... and must be clear and legible."); *see also Moke America LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at *1 n.6 (TTAB 2020) (the Board noted multiple blank pages of an exhibit attached to a testimony affidavit; party who introduces documents must ensure they are complete and legible), *appeal filed*, No. 3:20-cv-00400-MHL (E.D. Va. June 5, 2020).

of 20 TTABVUE. We shall refer to 22 TTABVUE, if necessary, to discern the purposes for which Applicant filed its documents.

⁶ These materials were already made of record by way of Opposer's original Notice of Reliance [16 TTABVUE]. These entirely duplicative items should not have been submitted again. *ITC Entertainment Grp.*, 45 USPQ2d at 2022-23.

III. Opposer's Evidentiary Objections

Before proceeding to the merits of the opposition, we address the evidentiary objections raised by Opposer in an Appendix to its Trial Brief.⁷ Applicant responded to Opposer's objections in an Appendix to Applicant's Trial Brief.⁸

Opposer objects to Applicant's submission of expired third-party trademark registrations and pending third-party trademark applications submitted with Applicant's Notice of Reliance (A NOR, 20 TTABVUE, Exhs. 25, 29, 31, 39, 40 and 45). Applicant points out that it did not rely on any of these exhibits in its Trial Brief, and thus argues that Opposer's objections are moot. We consider below Opposer's objections to these exhibits when discussing the strength of Opposer's registered FLEX, **flex** and FLEX PULSE marks.

On relevance grounds, Opposer objects to Applicant's submission of Opposer's answers to Applicant's Interrogatory Nos. 1-4, 8, and 9 (A NOR, 20 TTABVUE, Exh. 69). Opposer's "relevance objections, are overruled. Suffice it to say, 'we simply accord the evidence whatever probative value it deserves, if any at all ... Ultimately, the Board is capable of weighing the relevance and strength or weakness of the objected-to testimony and evidence in this specific case, including any inherent limitations.'" *Spotify AB v. U.S. Software Inc.*, 2022 USPQ2d 37, at *6 (TTAB 2022) (quoting *Hunt Control Sys. Inc. v. Koninkijke Philips Elecs. N.V.*, 98 USPQ2d 1558,

⁷ Opposer's Trial Brief, 34 TTABVUE 46-56.

⁸ Applicant's Trial Brief, 35 TTABVUE 40-46.

1564 (TTAB 2011)). We have kept Opposer's objections in mind in considering and determining the probative value of Applicant's evidence. *Id.*

Opposer objects to paragraphs 9-14 of and Exhibits 7-9 to Karine Malzahn's testimony declaration on grounds of lack of personal knowledge, lack of authentication and hearsay. Applicant responds that all of Opposer's objections concerning this declaration testimony and exhibits are foundational complaints in the nature of procedural defects that could have been cured if raised promptly, and therefore are improper to raise for the first time in Opposer's Trial Brief. We agree. *Moke America*, 2020 USPQ2d 10400, at *3-9. Even if considered substantive in nature, it is well-established general Board policy to not strike testimony taken in accordance with applicable rules on the basis of substantive objections, and instead to consider the objections when evaluating the probative value of the testimony at final hearing. *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1047 (TTAB 2017) (Board overruled objections to declaration testimony based on hearsay, lack of personal knowledge, and irrelevance, and that it is opinion testimony from a non-expert). Opposer's objections to the noted paragraphs of and exhibits to Ms. Malzahn's testimony declaration therefore are overruled.

IV. The Parties

Opposer provides technology innovation, supply chain and manufacturing products and services to diverse industries and markets. It renders design, manufacturing and supply chain services throughout the United States and internationally. Opposer's supply chain logistics management and manufacturing capabilities include inventory and freight management, build/configure to order,

order fulfillment and distribution, asset tracking, and supply chain network design. Its reverse logistics services include returns management, exchange programs, repair, asset recovery, recycling and e-waste management.⁹

Applicant provides products and services that allow businesses and consumers to remotely monitor and track the location, activity and status of vehicles, trailers, and other mobile assets such as cargo. Applicant's products include its fleet tracking system, comprising electronic devices installed in vehicles or trailers used in conjunction with fleet tracking software that allow users to monitor their vehicles or trailers. Applicant's electronic devices can include GPS-tracking technology to track the location of the assets, as well as sensors that provide a variety of vehicle and trailer information, such as tire pressure, temperature, door movement and cargo condition. Applicant's electronic devices also include wireless transceivers for communicating information from its electronic devices such that they may be remotely accessed using Applicant's fleet tracking software.¹⁰

V. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a threshold issue that must be proven by the plaintiff in every inter partes case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action under Trademark Act Section 13, 15 U.S.C., § 1063, a plaintiff must demonstrate "an interest falling within the zone of interests protected

⁹ Opposer's March 31, 2020 Annual Report (Form-10K) filed with the Securities and Exchange Commission, O NOR, 16 TTABVUE 409-413.

¹⁰ Malzahn Decl., 19 TTABVUE 2, ¶¶ 3-4.

by the statute and ... proximate causation.” *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021), (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014)).¹¹ Stated another way, a plaintiff is entitled to bring a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021); *see also Empresa Cubana*, 111 USPQ2d at 1062.

There is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d 11277 at *4. Thus, “a party that demonstrates a real interest in [oppos]ing a trademark under [Trademark Act Section 13, 15 U.S.C.] § 106[3] has demonstrated an interest falling within the zone of interests protected by [the Trademark Act] Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 106[3].” *See Corcamore*, 2020 USPQ2d 11277 at *7.

¹¹ Our decisions have previously analyzed the requirements of Trademark Act Sections 13 and 14, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” We now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Trademark Act Sections 13 and 14 remain applicable. *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

Opposer made of record the Trademark Status & Document Retrieval (“TSDR”) registration records for its pleaded FLEX, **flex** and FLEX PULSE marks.¹² Opposer thus has established its entitlement to bring a claim under Trademark Act Section 2(d). *Cunningham*, 55 USPQ2d at 1844.

VI. Priority

Because Opposer relies on its asserted FLEX, **flex** and FLEX PULSE trademark and service mark registrations that have been made of record,¹³ and Applicant has not challenged these registrations by way of any cancellation counterclaim(s), Opposer’s priority is not at issue with respect to the goods and services identified in its registrations. *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

VII. Likelihood of Confusion

Trademark Act Section 2(d) prohibits the registration of a mark that:

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

¹² Notice of Opposition, 1 TTABVUE 13-29; duplicates at O NOR, 16 TTABVUE 18-43, Exhs. A.1-A.3.

¹³ As noted, Opposer also relies on prior common law rights in its FLEX and **flex** marks in connection with “asset tracking devices,” as alleged in its Notice of Opposition. However, as observed by Applicant in its brief, 35 TTABVUE 26, Opposer repeatedly answered Applicant’s interrogatory answers by stating “Opposer is not relying on its FLEX branded asset trackers in this proceeding.” Opposer’s Responses to Applicant’s First Set of Interrogatories, A NOR, 20 TTABVUE 247-248, Resp. Nos. 9-12. We therefore need not, and do not, make any findings regarding prior common law uses of Opposer’s pleaded FLEX and **flex** marks on goods or services not recited in Opposer’s registrations for these marks.

Our analysis is based on all of the probative evidence of record. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (noting the elements, or factors, to be considered). In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In applying the *DuPont* factors, we bear in mind the fundamental purposes underlying Trademark Act Section 2(d), which are to prevent confusion as to source and to protect trademark owners from damage caused by registration of confusingly similar marks. *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1163 (1995); *DuPont*, 177 USPQ at 566.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the

marks.”). We discuss below these factors, and the other *DuPont* factors for which there is evidence and argument.

A. The Parties’ Marks

In our evaluation of the similarity or dissimilarity of the parties’ marks, the first *DuPont* factor, *DuPont*, 177 USPQ at 567, we first consider the strength of Opposer’s marks and then compare the respective marks in their entireties.

1. Strength of Opposer’s Marks

Turning to the strength of Opposer’s marks, *DuPont*, 177 USPQ at 567, which affects the scope of protection to which they are entitled, we consider Opposer’s marks’ conceptual strength, based on the nature of the marks themselves, and their commercial strength, based on marketplace recognition of the mark. *See In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”). The commercial strength of the mark also is affected by the number and nature of third-party uses of similar marks for similar goods. *DuPont*, 177 USPQ at 567.

As Opposer’s FLEX, **flex** and FLEX PULSE marks are registered on the Principal Register without a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f), they are presumed to be inherently distinctive for the goods and services recited in those registrations. *Tea Bd. of India v. Republic of Tea, Inc.*, 80 USPQ2d 1881, 1889 (TTAB 2006). Challenging the inherent strength of Opposer’s marks, Applicant states that “the ‘FLEX’ portion of... [both parties’ marks] is a highly suggestive, weak term[,]” citing to the dictionary definition of “FLEX” as

a shortened form of “flexible.”¹⁴ However, Applicant does not direct us to any evidence that Opposer’s marks are highly suggestive or weak in connection with the goods or services recited in Opposer’s registrations. Whether a mark is inherently strong or weak is determined in relation to the goods or services as identified in the registration; that a term has different meanings in different contexts is not controlling. *Cf. In re Bright-Crest Ltd.*, 204 USPQ 591, 593 (TTAB 1979) (“[S]ince the question of descriptiveness must be determined in relation to the goods or services for which registration is sought, the fact that a term may have meanings other than the one the Board is concerned with is not controlling on the question.”).

As another basis to challenge the conceptual strength of Opposer’s marks, Applicant argues that “third parties have registered numerous “flex” marks for logistics related goods and services[,]”¹⁵ pointing us to 30 third-party registrations and applications that it made of record.¹⁶ “[T]hird-party registration evidence that does not equate to proof of third-party use may bear on conceptual weakness if a term is commonly registered for similar goods or services.” *Tao Licensing*, 125 USPQ2d at 1057. However, four of the third-party registrations that Applicant provided have been cancelled.¹⁷ We therefore do not consider these references. *Sunnen Prods. Co. v. Sunex Int’l Inc.*, 1 USPQ2d 1744, 1747 (TTAB 1987) (An expired or cancelled

¹⁴ Applicant’s Trial Brief, 35 TTABVUE 17, citing to definition of “FLEX” from Dictionary.com, A NOR 20 TTABVUE 168, Exh. 53.

¹⁵ Applicant’s Trial Brief, 35 TTABVUE 34.

¹⁶ Third-party registrations, A NOR, 20 TTABVUE 72-162, Exhs. 22-52.

¹⁷ The cancelled registrations are for the following marks: FLEX (Exh. 23), FLEXNET (Exh. 29), FLEX FLAWLESS EXECUTION (Exh. 31) and FLEXFLEET (Exh. 32).

registration is evidence of nothing but the fact that it once issued.). We also do not consider the three third-party applications that Applicants submitted.¹⁸ Third-party applications are evidence only of the fact that they have been filed, *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009), and have no other probative value, *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003).

“Third-party registrations ‘may bear on conceptual weakness if a term is commonly registered for similar goods or services.’” *Sabhnani*, 2021 USPQ2d 1241, at *22 (quoting *Tao Licensing*, 125 USPQ2d at 1057). However, three of the third-party registrations that Applicant made of record are for unrelated goods or services.¹⁹ We do not consider these references in our analysis. In addition, 15 of these marks are compound terms including another word or letters in addition to “FLEX” that change the overall meaning and/or commercial impression of the marks as a whole, making them less similar to Opposer’s marks than is Applicant’s mark. *Sabhnani*, 2021 USPQ2d 1241, at *25 (citing *In re Inn at St. John’s*, 126 USPQ2d 1742, 1745-46 (TTAB 2018), *aff’d mem.*, 777 F. App’x 516 (Fed. Cir. 2019) (discounting probative value of third-party registrations “contain[ing] the

¹⁸ The pending applications are for the following marks: FLEX (Exh. 25), WAREFLEX (Exh. 39) and FLEXPORT (Exh. 40).

¹⁹ The registrations reciting irrelevant goods or services are for the following marks: FLEX (Exh. 26), FLEX (Exh. 27) and AGRI-FLEX (Exh. 49).

nonidentical term ‘Fifth’ in showing that the cited registered mark 5IVESTEAK was weak).²⁰ We therefore afford low probative value to these third-party registrations.

Stripped of the third-party registrations and applications that have no or low probative value, we are left with the five following relevant third-party registered marks that Applicant made of record:

Mark	Reg. No.	Goods/Services
FLEX	2210058 (Exh. 22)	Computer software used for logistics management, namely, for the Services management and processing of international cargo transport information in the field of the international transportation of cargo within the manufacturing, wholesale, retail and associated shipping industries, and manuals sold as a unit. Class 9
FLEX	4306388 (Exh. 24)	Computer software platform for use In managing contract obligations, optimizing contract performance, managing contract lifecycles, optimizing business relationships, tracking payments, calculating and tracking prices, tracking rebates, managing revenue, analyzing profitability, monitoring risks, monitoring regulations, and managing supply chains. Class 9 Providing temporary use of non-downloadable computer software platform for use in managing contract obligations, optimizing contract performance, managing contract lifecycles, optimizing business relationships, tracking payments, calculating and tracking prices, tracking rebates, managing revenue, analyzing profitability, monitoring risks, monitoring regulations, and managing supply chains. Class 42
LOAD FLEX	6146796 (Exh. 42)	Computer software development in the field of freight transportation by truck, rail, air and ocean. Class 42
VALUE FLEX	5159221 (Exh. 48)	Packing, loading and unloading of portable cargo containers; transport and delivery of portable cargo containers by truck. Class 39
FLEX	5271180 (Exh. 51)	Advanced transportation controller for managing a variety of intelligent transportation systems, including traffic signal control and integration with connected or automated vehicles. Class 9

²⁰ The registered marks containing additional elements to the term FLEX for which we discount their probative value are the following: FLEXPROCESS (Exh. 28), FLEXNET and Design (Exh. 30), AMAFLEX and Design (Exh. 33), MORGAN FLEXSHIP (Exh. 34), FIELDFLEX IN-STORE SERVICES WORLDWIDE (Exh. 35), FREIGHTFLEX (Exh. 36), FLEXFLOOR (Exh. 37), SCFLEX (Exh. 38), FLEXSCAN (Exh. 41), FLEXLOGIC (Exh. 43),

While the Federal Circuit has held that “**extensive** evidence of third-party use and registrations is ‘powerful on its face,’ even where the specific extent and impact of the usage has not been established,” see *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015) (emphasis added) (citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)), the record of third-party registrations in this case is far less than the amount of evidence found convincing in *Jack Wolfskin* and *Juice Generation* wherein “considerable evidence of third-party registration[s]” of similar marks was shown. *Id.*

In sum, on this record Applicant has failed to establish that Opposer’s marks are so conceptually weak that they are not entitled to protection against Applicant’s marks. See *New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 USPQ2d 10596, at * 11 (TTAB 2020) (“[We have ... minimal evidence of registrations of marks comprised of ERA for the same or similar goods that might demonstrate the inherent weakness of the ERA component [of Opposer’s mark] as a source identifier. Thus, on this record, Opposer’s NEW ERA mark for the identified goods is conceptually strong, and ... Applicant has not shown that the mark has been weakened.”).

On the marketplace or commercial strength side of the distinctiveness equation, Applicant contends “Opposer has not asserted that its marks are famous or submitted evidence that would support such an assertion. Thus, Opposer’s marks have not

FLEXPORT (Exh. 44), VDO FLEX LIGHT (Exh. 46), BAD ELF FLEX (Exh. 47), AMAZON FLEX (Exh. 50) and STEVENS FLEX-SHIP (Exh. 52).

acquired fame sufficient to warrant a heightened degree of protection.”²¹ Since Opposer did not assert its marks are famous, Applicant’s argument in this regard is moot. On the other hand, Opposer has not established that its pleaded marks are commercially strong.

Marketplace strength “for [likelihood of] confusion purposes arises as long as a significant portion of the relevant consuming public recognizes the mark as a source indicator,” and “likelihood of confusion ... [commercial strength] varies along a spectrum from very strong to very weak.” *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (cleaned up).

The commercial strength of a mark may be measured indirectly by the volume of sales of and advertising expenditures for the goods and services identified by the marks at issue, the length of time those indicia of commercial awareness have been evident, widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305-06 and 1309 (Fed. Cir. 2002). Raw numbers alone may be misleading, however. Thus, some context in which to place raw statistics may be necessary, for example, market share or sales or advertising figures for comparable types of goods. *Id.* at 1309. Market share information, however, is not a *sin qua non* element to establish commercial strength. “[C]ontextual evidence of the type of advertisements and promotions ... [the plaintiff] uses to gain sales” showing how “the

²¹ Applicant’s Trial Brief, 35 TTABVUE 33.

consuming public has been regularly exposed to ... [the plaintiff's mark] on a ... [broad] scale” may be sufficient. *Omaha Steaks Int’l, Inc. v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 USPQ2d 1686, 1690-91 (Fed. Cir. 2018).

Using *Bose* and *Omaha Steaks* as our guideposts, absent from the evidentiary record is any information regarding the volume of sales of and advertising expenditures for the goods and services identified by Opposer’s marks. According to Opposer’s pleaded registrations,²² the FLEX and **flex** marks have been in use in commerce since 2015; the FLEX PULSE registration contains a convention priority date in 2015. Mr. Kilburn’s testimony declaration and web page exhibits demonstrate use of the FLEX and **flex** marks as early as 2017.²³ Opposer introduced one media article assessing Opposer’s products and services provided in connection with the FLEX and FLEX PULSE marks from 2016,²⁴ and six examples of its website promotional advertising of the products and services associated with its FLEX, **flex** and FLEX PULSE marks from 2015, 2018 and 2021 (with no indication as to the number of unique Internet users who accessed these online sources). Opposer provided no market share information for the products and services promoted and sold in connection with its marks.

In an effort to demonstrate the marketplace weakness of Opposer’s marks, Applicant argues that “numerous entities are using ‘flex’ marks for ... [logistics-

²² Opposer’s registrations (and TSDR information therefor), Notice of Opposition, 1 TTABVUE 12-29.

²³ Kilburn Decl., 18 TTABVUE 2, 7-16, ¶¶ 6-9, Exhs. A-C.

²⁴ O NOR, 16 TTABVUE 523-525, Exh. E.1

related] goods and services.”²⁵ In support, Applicant made of record 15 third-party websites showing uses of company and product names including the term “... FLEX ...”.²⁶

“The purpose of introducing evidence of third-party use is ‘to show that customers have become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different [such] marks on the bases of minute distinctions.’” *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)). Third-party uses may bear on the commercial weakness of a mark, *Tao Licensing*, 125 USPQ2d at 1057, and may be “relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Omaha Steaks*, 128 USPQ2d at 1693 (quoting *Palm Bay Imps.*, 73 USPQ2d at 1694); *see also Sabhnani*, 2021 USPQ2d 1241, at *22. As we said regarding Applicant’s third-party registration evidence, for third-party use evidence to be probative on the question of commercial weakness it must show use “of similar marks on similar goods [or services] ...” *In re FabFitFun*, 127 USPQ2d 1670, 1674 (TTAB 2018) (quoting *Palm Bay Imps.*, 73 USPQ2d at 1693).

We therefore find of low probative value Applicant’s evidence of third-party use of marks and names associated with irrelevant goods and services,²⁷ and such marks

²⁵ Applicant’s Trial Brief, 35 TTABVUE 34.

²⁶ A NOR, 20 TTABVUE 172-238, Exhs. 54-68.

²⁷ Third-party marks associated with irrelevant goods and services include: FLEXTERM (Exh. 59), AMAZON FLEX (Exh. 60), MORGAN FLEX●SHIP (Exh. 61) and FIELDFLEX (Exh. 62 – confined to commercial real estate, irrelevant channels of trade).

containing additional elements that cause many of them to be less similar to Opposer's marks than is Applicant's mark.²⁸

Stripped of the third-party uses for which afford no or low probative value, we are left with the eight following relevant third-party uses that Applicant made of record:

Mark	Source	Goods/Services
FLEX FLEET	flexfleetgps.com (Exh. 54)	GPS fleet management solutions
FLEXGPS	flexgps.net (Exh. 55)	Telematics (GPS technology) - interaction with feet through maps, messaging, filters, and vehicle information from the convenience of a smart device
FLEX LOGISTICS	flexlogistics.com (Exh. 56)	Logistics management system, storage and transportation options, warehouse management system
FLEXE	flexe.com (Exh. 57)	Shipping, warehousing, order fulfillment, supply chain logistics services
FLEX	flexrentalsolutions.com (Exh. 58)	Inventory management and rental software, asset management, warehouse management, asset and inventory tracking
FLEX FREIGHT	flex-freight-llc.business.site (Exh. 65)	freight brokerage, transportation requirements (tractor trailer loads, freight supply chain management
FLEX TRUCKING	flextruckingco.com (Exh. 66)	Transportation management, freight brokerage, freight management
FLEX DIAMOND TRUCKING	flexdiamondtrucki ngllc.com (Ex 67)	Freight logistics, shipping, cargo handling

Once again, the record of third-party uses in this case is far less than the amount of evidence found convincing in *Jack Wolfskin* and *Juice Generation* wherein “extensive evidence of third-party uses” of similar marks was shown. *Jack Wolfskin*, 116 USPQ2d at 1136; *Juice Generation*, 115 USPQ2d at 1674.

²⁸ The third-party marks and names containing additional elements to the term FLEX for which we discount their probative value are the following: FLEXPOR (Exh. 63), SCFLEX (Exh. 64) and LOGIFLEX (Exh. 68).

We have evaluated as a whole the conceptual strength of Opposer's pleaded marks, based on the nature of the marks themselves and any evidence Applicant provided to contest their inherent strength, as well as the dearth of proof of the commercial strength of Opposer's marks accompanied by Applicant's evidence of third-party uses of similar marks and names. We find that Opposer's pleaded marks are inherently distinctive for the goods and services recited in Opposer's registrations, and that Applicant's evidence and argument are insufficient to alter this finding.

Regarding commercial strength, "[t]he proper standard is the mark's 'renown within a specific product market,' ... and 'is determined from the viewpoint of consumers of like products,' ..., and not from the viewpoint of the general public." *Chutter, Inc. v. Great Mgt. Grp., LLC*, 2021 USPQ2d 1001, at *31 (TTAB 2021) (quoting *Joseph Phelps Vineyards*, 122 USPQ2d at 1734-35). By this measure, we have insufficient evidence to find Opposer's marks used in connection with their recited goods and services have achieved any degree of commercial recognition by the relevant purchasing public. On the "spectrum from very strong to very weak[.]" *Joseph Phelps Vineyards*, 122 USPQ2d at 1734, we afford Opposer's marks "the normal scope of protection to which inherently distinctive marks are entitled." *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1347 (TTAB 2017).

2. The Similarity or Dissimilarity of the Marks

We now consider the similarity or dissimilarity of the parties' marks in their entirety as to appearance, sound, connotation and commercial impression, *See Palm Bay Imps.*, at 73 USPQ2d at 1691, the first *DuPont* factor. *DuPont*, 177 USPQ at 567.

“Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018), *aff’d mem.*, Slip Op. No. 18–2236 (Fed. Cir. Sept. 13, 2019) (quoting *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)).

“The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (quoting *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (internal quotation marks omitted). The focus is on the recollection of the average purchaser – here a potential purchaser of products and services for monitoring the transportation of goods, and the means for transporting those goods – who normally retains a general rather than a specific impression of trademarks. *In re Assoc. of the U.S. Army*, 85 USPQ2d 1264, 1268 (TTAB 2007); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

So long as we “analyze[] the marks as a whole[, i]t is not improper for the Board to determine that, ‘for rational reasons,’ ... [we] give ‘more or less weight ... to a particular feature of the mark[s]’ provided that ... [our] ultimate conclusion regarding ... likelihood of confusion ‘rests on [a] consideration of the marks in their entirety.’” *Quiktrip W., Inc. v. Weigel Stores, Inc.*, 2021 USPQ2d 35, *2-3 (Fed. Cir. 2021) (quoting *Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 1357 (Fed. Cir. 2000) and *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985)).

We begin by recognizing the obvious: Applicant's FL FLEX mark shares the identical term "FLEX" with each of Opposer's FLEX, **flex** and FLEX PLUS marks. "FLEX" is the only term in Opposer's FLEX and **flex** marks, as well as the first and thus dominant term in Opposer's FLEX PLUS mark. *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

We find that the stylization of the lettering in Opposer's **flex** mark does not distinguish it from Applicant's FL FLEX mark as a source identifier. Because Applicant seeks registration of its mark in standard characters, were the FL FLEX mark to register Applicant would not be limited to any particular depiction of its mark; the mark could be displayed in any lettering style, as the rights would reside in the wording and not in any particular display. *In re Viterra*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re White Rock Distilleries Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009). Thus, Applicant could display its FL FLEX mark in the identical font style, size and color in which the literal element of Opposer's **flex** mark is shown. *See* Trademark Rule 2.52(a); 37 C.F.R. § 2.52(a).

We further find that the term "PLUS" in Opposer's FLEX PLUS mark is merely laudatory with respect to Opposer's identified products and services. As an adjective, "PLUS" is defined as "having, receiving, or being in addition to what is anticipated,"

“greater than that specified,” or “possessing a specified quality to a high degree.”²⁹ At least one trade media source considers the term “PLUS” in Opposer’s FLEX PLUS mark to have such a meaning.³⁰ As such, inclusion of the term “PLUS” in Opposer’s FLEX PLUS mark does not serve to distinguish this mark from Applicant’s FL FLEX mark as a designation of source. *Palm Bay Imps.*, 3 USPQ2d at 1692 (affirming Board’s holding that contemporaneous use of the applicant’s mark, VEUVE ROYALE, for sparkling wine, and the opposer’s marks, VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN, for champagne, is likely to cause confusion, noting that the presence of the “strong distinctive term [VEUVE] as the ... [common] word in both parties’ marks render[ing] the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE”); *see also Plus Prods. v. Redken Lab’s, Inc.*, 199 USPQ 111, 116 (TTAB 1978) (“PLUS’ is a dictionary word which denotes something better or an additional quality or quantity and, as such, possesses a highly suggestive significance as applied to most classes of goods.”).

Applicant merely added the letters “FL” to each of Opposer’s FLEX, **flex** and FLEX PLUS marks, and deleted the term “PLUS” from Opposer’s FLEX PLUS mark.

²⁹ Definition of “PLUS” from MERRIAM-WEBSTER online (<https://www.merriam-webster.com/dictionary/plus>, last visited January 20, 2022). The Board may take judicial notice of dictionary definitions from online sources when the definitions themselves are derived from dictionaries that exist in printed form or have regular fixed editions. *McGowen Precision Barrels, LLC v. Proof Research, Inc.*, 2021 USPQ2d 559, *24 n.93 (TTAB 2021). We exercise our discretion to do so here.

³⁰ “Flex Pulse ... [is] a software-based mobile collaboration tool that provides unprecedented real-time intelligence for managing global supply chains.” Webb, J., *Flex Takes A Silicon Valley Approach To Reducing Supply Chain Risk*, FORBES.COM (September 27, 2016), O NOR, 16 TTABVUE 523-25.

We find the mere addition of two letters, “FL,” in Applicant’s FL FLEX mark is not enough to distinguish Applicant’s mark from any of Opposer’s marks in appearance, sound or commercial impression.

Arguing to the contrary, Applicant posits the following:³¹

- “FL” is the first, arbitrary and dominant portion of Applicant’s FL FLEX mark.
- “FL” is Applicant’s “house mark” and an abbreviation for Applicant’s “FleetLocate” electronic device mark.
- Applicant owns several registrations for “FL” electronic tracking device and wireless data transceiver trademarks (e.g., FL SOLAR, FL1, FL4, FL7, FL12, FL14, FL18, FL22 and FL700), and Applicant routinely uses the “FL” formative in this way.
- Applicant uses the FL FLEX mark in connection with electronic devices that are used in conjunction with its FleetLocate fleet tracking system.
- The “FLEX” portion of Applicant’s FL FLEX mark is a highly suggestive, weak term.
- Applicant selected “FLEX” for inclusion in its mark to suggest “flexibility” because the FL FLEX device has a modular configuration that provides a high degree of flexibility to trailer fleet owners in how the device is installed, and in the wide range of external sensors it supports.
- Only minor differences in the parties’ marks or the goods/services with which they are used will be sufficient to avoid confusion.
- Consumers encountering the FL FLEX mark on an asset tracker will not be confused into believing that its FL FLEX product is affiliated with Opposer, but instead will focus on the dominant first term “FL” and understand that it is another one of Applicant’s numerous “FL ...” marked asset tracking products.
- The “FL” designation not only distinguishes the FL FLEX mark from Opposer’s marks in appearance, but also by sound with the separate “ef” and “el” sounds at its beginning.

³¹ Applicant’s Trial Brief, 35 TTABVUE 11-13 and 17-25, relying on testimony and exhibits (advertising brochure, spec sheet, installation guides and press release) from Karine Malzahn’s Declaration. Malzahn Decl., 19 TTABVUE 2-5, 9-84, 94-97, ¶¶ 4-8, 14, Exhs. 1-5, 9, and the registrations for Applicant’s “FL ...” and FLEETLOCATE marks, A NOR, 20 TTABVUE 39-71, Exhs. 11-21. *See also* Applicant’s Answer to Opposer’s Interrogatory No. 11, O NOR, 16 TTABVUE 61, providing this same summary of facts and arguments.

We have several factual and legal problems with Applicant's contentions. As noted above in our discussion regarding the strength of Opposer's marks, Applicant has not sufficiently shown that FLEX is weak as it is used in Opposer's marks and in connection with Opposer's goods and services. Further, Applicant has not demonstrated that relevant consumers understand the "FL..." element is Applicant's "house mark" and an abbreviation for Applicant's "FleetLocate" electronic device mark. Even if Applicant did submit such proof, likelihood of confusion cannot be avoided by incorporating the entirety of the FLEX element of Opposer's marks and combining it with the additional, non-distinctive letters "FL." *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014) (holding "the Board did not err in finding that 'STONE LION CAPITAL' is 'similar in sight, sound, meaning, and overall commercial impression' to [the opposer's] 'LION CAPITAL' and 'LION' [marks]" and "by according little weight to the adjective 'STONE,' on the ground that it did not 'distinguish the marks in the context of the parties' services.>"). In fact, relevant consumers could very well have the impression that the "FL..." element emphasizes the first two letters of the FLEX element in all three of Opposer's marks.

Further, merely because the "FL..." element appears first, or is purportedly dominant in Applicant's FL FLEX mark (as Applicant claims), does not necessarily avoid confusion. *See Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003-04 (Fed. Cir. 2002) (Affirming the Board's finding that the applicant's PACKARD TECHNOLOGIES mark and the opposer's HEWLETT

PACKARD marks conveyed a similar commercial impression, notwithstanding that “PACKARD” appears first (and is dominant) in the applicant’s mark and second (but prominent) in the opposer’s marks).

Comparing the parties’ marks in their entireties, we find that Applicant’s FL FLEX mark is highly similar to Opposer’s FLEX and **flex** marks, and highly similar to Opposer’s FLEX PLUS mark, in appearance, sound, meaning and overall commercial impression. In sum, we find the first *DuPont* factor supports a finding that confusion is likely.

B. The Similarity or Dissimilarity of the Parties’ Goods and Services

We now turn to the comparison of the goods and services at issue, the second *DuPont* factor. In making our determination regarding the relatedness of the goods and services, we must look to the goods and services as identified in Applicant’s application and Opposer’s registrations. *See Stone Lion*, 110 USPQ2d at 1162 (quoting *Octocom Sys., Inc. v. Hous. Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods [or services], the particular channels of trade or the class of purchasers to which the sales of goods [or services] are directed.”)); *see also Paula Payne Prods. v. Johnson Publ’g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) (“Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods”).

Further, “the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion.” *L’Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1440 (TTAB 2012) (quoting *In re Concordia Int’l Forwarding Corp.*, 222 USPQ 352, 356 (TTAB 1983)). Where, as in this case, Applicant’s FL FLEX mark is nearly identical to Opposer’s FLEX and **flex** marks, and highly similar to Opposer’ FLEX PLUS mark, “there need only be a viable relationship between the goods [and services] to find that there is a likelihood of confusion.” *Id.* (citing *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993) (contemporaneous use of identical or nearly identical marks can lead to the assumption that there is a common source “even when [the] goods or services are not competitive or intrinsically related”). “It is sufficient that the respective goods [and services] are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods [and services] are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer.” *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006).

A useful shortened description of Applicant’s identified goods are electronic tracking devices for cargo and freight transportation equipment (enabled by GPS and cellular communications technology). A shortened description of Opposer’s identified services for its FLEX and **flex** marks, most applicable to this Opposition, are supply chain management and transportation logistics services, as well as

engineering, design and manufacturing services in the field of electronics. A shortened description of Opposer's identified goods and services for its FLEX PULSE mark are computer hardware and software for use in supply chain and logistics management, inventory management, and goods transportation scheduling, supply chain management and transportation logistics services, as well as engineering and design services in the field of electronics.

Opposer argues that: (1) its electronics engineering, design and manufacturing services for electronics include such services in the production of Applicant's electronic tracking devices; (2) its tracking software is highly related and complimentary to Applicant's electronic tracking devices; (3) Applicant's type of electronic tracking devices can be used in connection with Opposer's type of supply chain management and transportation logistics services; and (4) Opposer's goods and services and Applicant's goods often emanate from a single source. Consequently, due to the similarities in the marks, relevant consumers would reasonably believe that Applicant's goods originate with Opposer.³²

Applicant argues that its electronic tracking devices are not sufficiently related to Opposer's manufacturing and development services, software or supply chain and logistics management services for confusion to occur. Applicant also contends Opposer's evidence that Opposer's types of goods and services and Applicant's type of

³² Opposer's Trial Brief, 34 TTABVue 26-34

goods emanate from a single source should be afforded minimal weight and therefore is insufficient.³³

Literally, Opposer's electronics engineering, design and manufacturing services identified in its FLEX and **flex** registrations are broad enough to cover such services for producing Applicant's goods. Applicant seeks to limit the scope of protection for Opposer's marks based upon arguments that the parties' customers are different.³⁴ However, there are no customer-type limitations in the identifications of goods and services in Opposer's registrations, and we may not read any such limitations into them. *See Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) ("There is no specific limitation ... and nothing in the inherent nature of [registrant's] mark or goods that restricts the [ir] usage The Board, thus, improperly read limitations into the registration."); *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1825-26 (TTAB 2009) ("[A]bsent any explicit restriction in ... [an] application or registration, we must presume the parties' identified goods ... travel through all normal channels of trade for goods of the type identified, and we must consider them to be offered and sold to all of the usual customers for such goods.").

³³ Applicant's Trial Brief, 35 TTABVUE 26-30.

³⁴ Applicant's Trial Brief, 35 TTABVUE 27.

Opposer's assertion that its FLEX PLUS tracking software is highly related and complimentary to Applicant's electronic tracking devices is supported by the testimony of Applicant's witness, Ms. Malzahn:³⁵

4. [Applicant's] ... FleetLocate fleet tracking system ... includes ... [Applicant's] FleetLocate fleet tracking software in conjunction with electronic devices installed in vehicles and/or trailers that allow the software users to monitor the vehicle/trailer. The electronic devices can include GPS-tracking technology to track the location of the assets. ... The electronic devices each include wireless transceivers for wirelessly communicating information from the electronic device such that it may be remotely accessed using the FleetLocate fleet tracking software.

Applicant's claim that "[Applicant]'s goods and Opposer's software services are not competitive and do not have overlapping customers"³⁶ again is an impermissible attempt to read limitations into the scope and coverage of Opposer's FLEX PLUS registration. *Squirtco*, 216 USPQ at 940; *Anheuser-Busch*, 115 USPQ2d at 1825-26.

Opposer's contention that Applicant's type of electronic tracking devices can be used in connection with Opposer's type of supply chain management and transportation logistics services is supported by Applicant's following admissions:³⁷

REQUEST FOR ADMISSION NO. 31: Admit that Applicant's electronic devices for tracking the locations of mobile assets in the nature of trailers, cargo containers, and other freight and transportation equipment using global positioning systems and cellular communications networks may be used by consumers in the field of supply chain management and logistics. RESPONSE: Admitted.

REQUEST FOR ADMISSION NO. 32: Admit that Applicant's electronic devices for tracking the locations of mobile assets in the nature of trailers, cargo containers, and other freight and transportation

³⁵ Malzahn Decl., 19 TTABVUE 2, ¶ 4.

³⁶ Applicant's Trial Brief, 35 TTABVUE 28.

³⁷ Applicant's Responses to Opposer's Requests for Admissions, O NOR, 16 TTABVUE 51, Adm. Resp. Nos. 31-32.

equipment using global positioning systems and cellular communications networks may be used by consumers in the field of tracking telematics. RESPONSE: Admitted.

Applicant begrudgingly continues with this admission in its brief, wherein it acknowledges that “freight and transportation equipment may be tangentially related to supply chains, because they are used in transporting supplies”³⁸

However, Applicant seeks to disassociate itself from these admissions, by once more arguing that “[Applicant]’s goods and Opposer’s supply chain and logistics management services are not competitive and do not have overlapping customers,”³⁹ which again is an impermissible attempt to read limitations into the scope and coverage of Opposer’s FLEX and **flex** registrations that are not there. *Squirtco*, 216 USPQ at 940; *Anheuser-Busch*, 115 USPQ2d at 1825-26.

Opposer submitted 30 third-party registrations that cover both Opposer’s types of goods and/or services and Applicant’s type of goods to show that they often emanate from a single source and are thus are related.⁴⁰ Although active third-party registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the services listed therein are of a kind that may emanate from a single source under a single mark. *See Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1432 (TTAB 2013) (finding that third-party

³⁸ Applicant’s Trial Brief, 35 TTABVUE 29.

³⁹ Applicant’s Trial Brief, 35 TTABVUE 29.

⁴⁰ O NOR, 16 TTABVUE 70-202, Exhs. C.1-C.30.

registrations covering both wine and water were probative of the relatedness of those beverages).

However, 19 of those registrations are not based on use in commerce; but rather issued under Trademark Act Sections 44(e) or 66(a), 15 U.S.C. §§ 1126(e) or 1141f(a), based on the foreign trademark owners' home country registrations or as extensions of protection to the United States based on an international registration. Accordingly, they lack probative value, and we have not considered them. *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007) ("To the extent that the registrations are based on Section 44 or Section 66 of the Trademark Act, applicant's objection is well-taken. Because these registrations are not based on use in commerce they have no probative value in showing the relatedness of the services...."). This leaves 11 active, use-based registrations which we find support Opposer's position that Opposer's types of goods or services and Applicant's type of goods often emanate from a single source and are therefore related.

Opposer also made of record 20 third-party website pages showing the promotion of both Opposer's types of goods and/or services and Applicant's type of goods under the same company name or mark, to show that they often emanate from a single source and are thus are related.⁴¹ Evidence of third-party use of the same mark for an Applicant's identified goods (or similar goods) on the one hand, and Opposer's identified goods and services (or similar goods and services) on the other, can establish a relationship between those goods and services. *In re Detroit Athletic Co.*,

⁴¹ O NOR, 16 TTABVUE 546-640, Exhs. F.1-C.20.

903 F.3d 1297, 128 USPQ2d 1047, 1051 (Fed. Cir. 2018). Although Opposer has not presented specific evidence concerning the extent and impact of these uses, it nevertheless presented “evidence of these marks being used in internet commerce” for various transportation logistics products and services, some of which are identical or related to the goods and services identified in Applicant’s FL FLEX Application and Opposer’s FLEX, **flex** and FLEX PLUS registrations. *Jack Wolfskin*, 116 USPQ2d at 1136; *see also Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (Internet printouts “on their face, show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein.”).

Considering the record as a whole, we find the evidence supports that Opposer’s goods and services and Applicant’s goods are related. This second *DuPont* factor also supports a finding that confusion is likely.

C. Similarity or Dissimilarity of Trade Channels and Classes of Consumers

The third *DuPont* factor assesses the similarity or dissimilarity of the parties’ established, likely-to-continue trade channels and classes of consumers. *DuPont*, 177 USPQ at 567. Because there are no limitations as to channels of trade or target purchasers in the description of goods and services in Opposer’s FLEX, **flex** and FLEX PLUS registrations, it is presumed that Opposer’s identified goods and services would move in all channels of trade normal for those goods and services, and that they are available to all target purchasers for those goods and services. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir.

2011); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

The record shows that these trade channels include the websites of the providers of these goods and services.⁴²

As noted from this website evidence, there is proof in the record that the trade channels for the goods and services identified by the parties in their respective application and registrations overlap, and that these products and services are directed to the same classes of consumers – potential purchasers of products and services for monitoring the transportation of goods, and the means for transporting those goods. Opposer highlights the following evidence it made of record as part of its

Notice of Reliance:

- Shenzhen Eelink Communication Technology Co Ltd., offering asset tracking devices, tracking software, supply chain tracking services, original equipment manufacturing services, and original design manufacturing services.
- Sensitech Inc., offering asset tracking devices, tracking software, and supply chain tracking services.
- ShadowTrack 24/7, LLC, offering asset tracking devices, tracking software, supply chain tracking services and supply chain management services.
- Fleet Complete, offering asset tracking devices, tracking software and supply chain tracking services.
- DB SCHENKER, offering asset tracking devices, logistics services and supply chain management services.
- Digital Matter, offering asset tracking devices, original equipment manufacturing services and original design manufacturing services.

As we more generally noted above, the portions of Applicant's Trial Brief discussing trade channels and classes of consumers is corrupted, and therefore

⁴² O NOR, 16 TTABVUE 546-640, Exhs. F.1-C.20.

unreadable. We therefore do not have Applicant's position on this element of Opposer's case. Under the third *DuPont* factor, we find the parties' trade channels and classes of purchasers overlap, which also supports a finding that confusion is likely.

D. Other Established Arguably Probative Facts

The thirteenth *DuPont* factor considers “[a]ny other established fact probative of the effect of use.” *DuPont* 177 USPQ at 567. Opposer requests we make a finding that Applicant adopted its FL FLEX mark in bad faith based on the documented allegation that “Applicant had actual notice of Opposer's use of its ‘FLEX’ and ‘FLEX (Stylized)’ marks and Opposer's services involving the manufacture of asset tracking technology prior to the filing date of the Application and the alleged first use and first use in commerce date of Applicant's FL FLEX Mark.”⁴³

Between August 2017 and February 2018, the parties exchanged correspondence regarding Opposer's proposal to provide telematics (telecommunications and information processing) and asset tracking hardware – specifically, GPS tracking devices for tractor trailers – for Applicant to use in providing Applicant's services.⁴⁴ The parties' email exchanges resulted in Applicant's expression of interest, the execution of a mutual non-disclosure agreement, and a formal presentation (with

⁴³ Opposer's Trial Brief, 34 TTABVUE 38.

⁴⁴ Kilburn Decl., 18 TTABVUE 4, 17-22, ¶¶ 13-14 (redacted), Exhs. D-E; 17 TTABVUE 17-22, Exhs. D-E.

PowerPoint slides bearing the FLEX and **flex** marks throughout) given by Opposer to Applicant in April 2018.⁴⁵

Applicant acknowledges the solicitation from Opposer concerning its offer to manufacture trailer tracking devices, and the follow-on presentation given by Opposer to Applicant concerning a proposal to manufacture trailer tracking devices for Applicant. Applicant did not retain Opposer, and Opposer has not manufactured any trailer tracking devices for Applicant. Applicant claims not to have been aware of Opposer's use of the FLEX mark for any goods or services prior to Opposer's 2018 presentation to Applicant.⁴⁶

Applicant asserts it conceived the FL FLEX mark in February 2017, selected the mark for use with its electronic tracking device in April 2017, first used the mark externally in May 2017, first used it in connection with the sale of the device in December 2017, and formally announced its introduction of the FL FLEX device to the public by way of a press release in February 2018.⁴⁷ As noted earlier, Applicant's FL FLEX trademark application was filed in October 2018.

The premise of Opposer's bad faith allegation is that Applicant was aware of Opposer's rights in its FLEX and **flex** marks in connection with electronic tracking devices prior to the filing date of Applicant's FL FLEX application. However, as we noted above, Opposer repeatedly answered Applicant's interrogatory answers

⁴⁵ Kilburn Decl., 18 TTABVUE 4, ¶¶ 15-17; 17 TTABVUE 23-58, Exhs. F-G.

⁴⁶ Malzahn Decl., 19 TTABVUE 16.

⁴⁷ Malzahn Decl., 19 TTABVUE 5, 85-97, ¶¶ 10-14, Exhs. 7-9.

by stating “Opposer is not relying on its FLEX branded asset trackers in this proceeding.”⁴⁸ Doubling down on this assertion, Opposer states in its brief: “Opposer is relying solely on its registered trademark/service marks to oppose the subject application. The focus of this ... [proceeding] therefore should be on those registered trademarks rather than Opposer’s use of its marks in the marketplace.”⁴⁹

“[A]n inference of ‘bad faith’ requires something more than mere knowledge of a prior similar mark.” *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987). That is all that the record here shows, and moreover Opposer has disclaimed away its alleged common law rights in the FLEX and **flex** marks for electronic tracking devices—the very goods on which it relies to assert Applicant’s bad faith. The record before us does not support a finding of Applicant’s bad faith adoption under the thirteenth *DuPont* factor.

VIII. Likelihood of Confusion: Conclusion

Opposer’s FLEX, **flex** and FLEX PLUS marks are inherently distinctive, and there is insufficient evidence for us to find that they are commercially weak. Applicant’s FL FLEX mark is nearly identical to Opposer’s FLEX and **flex** marks, and highly similar to Opposer’s FLEX PLUS mark, in appearance, sound, meaning and overall commercial impression.

The evidence as a whole supports the conclusion that Opposer’s goods and services and Applicant’s goods are related, and that the parties’ trade channels and classes of

⁴⁸ Opposer's Responses to Applicant's First Set of Interrogatories, A NOR, 20 TTABVUE 247-248, Resp. Nos. 9-12.

⁴⁹ Opposer’s Trial Brief, 34 TTABVUE 51.

purchasers overlap. Opposer's evidence and arguments do not support its contention that Applicant adopted its FL FLEX mark in bad faith.

Decision:

The Opposition to registration of Applicant's FL FLEX mark on the ground of likelihood of confusion pursuant to Trademark Act Section 2(d) is sustained.